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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,321	04/13/2004	Mihir Sambhus	03226.424001; SUN030085	4495
32615	7590	10/05/2006	EXAMINER	
OSHA LIANG L.L.P./SUN 1221 MCKINNEY, SUITE 2800 HOUSTON, TX 77010			LEWIS, CHERYL RENE A	
			ART UNIT	PAPER NUMBER
			2167	

DATE MAILED: 10/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/823,321	Applicant(s) SAMBHUS ET AL.	
	Examiner Cheryl Lewis	Art Unit 2167	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-27 are presented for examination.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 2, 4, 6, 8, 11-22, 25, and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 2, 4, 6, 8, 11-22, 25, and 27 each respectively recite an "abstracted" or an "abstraction". The claimed limitation "abstracted" and "abstraction" refers to an application programming interface. However, *Webster's Dictionary* defines abstract (abstraction) "as difficult to understand". What type or kind of application program interface is being claimed?

Further, independent claims 8 and 21 recite performing an "operation". What type or kind of "operation" is being performed? What is the detailed functionality of this "operation"?

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1, 8, and 21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. As follows:

Claims 1, 8, and 21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 1 is directed to storing an abstracted application programming interface communicating between an application and an adapter, the adapter communicates between an abstracted application programming interface and one of a plurality of address book programs. Claim 8 is directed to (1) establishing an abstraction session, (2) implementing an abstraction session, (3) creating an abstraction of an opening address book program, (4) implementing an abstraction of an opening address book program, (5) generating an abstraction of an operation on an address book program, (6) and implementing an abstraction of an operation on an address book program. Claim 21 is directed to the same claim limitations as described above for independent claim 8. The claimed inventions, as a whole must accomplish a **practical application**. That is, it must produce a **“useful, concrete, and tangible result.”** *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02. *MPEP* 2106. In each of these cases the **result** is communicating between an abstracted application programming interface, an adapter, and one of a plurality of address book programs (claim 1); and establishing and implementing an abstraction of

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a session, creating and implementing an abstraction of opening an address book program, and generating and implementing an abstraction of an operation on an address book program (claims 8 and 21). The claimed limitations are an abstraction as they are not **useful, concrete, and tangible**, they are not put in any tangible form and not useful because they are not presented in such a way to provide some result that is of utility that may exist in the specification however no specific use is provided for in the claimed invention. Thus the claims are non-statutory and stand rejected under 101 as not producing a **"useful, concrete, and tangible result."**

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Monberg et al. (Patent No. 6,973,448 B1 filed August 30, 2000, hereinafter Monberg).

8. Regarding Claim 1, Monberg teaches a method and system for providing service listings in electronic yellow pages.

The method and associated system for providing service listings in electronic yellow pages as taught or suggested by Monberg includes:

an abstracted application programming interface (col. 8, lines 17 and 18, figure 2, element 220) for communicating between an application (figure 1, element 37, 'Application Programs') and an adapter (figure 1, element 48, 'Video Adapter', col. 4, line 47, figure 1, element 53); and an adapter for communication between an abstracted application programming interface and one of an address book programs (col. 6, lines 10, 'An Internet yellow pages provider...', col. 6, line 15, '...a yellow page website...').

9. Regarding Claims 2 and 9, Monberg teaches an abstracted application programming interface comprises a first set of programming code generic to a plurality of address book programs (col. 4, lines 15-20 and lines 60-67, col. 5, lines 1-9).

10. Regarding Claim 3, Monberg teaches a second set of programming code specific to one of a plurality of address book programs (col. 4, lines 15-20).

11. Regarding Claim 4, Monberg teaches an abstracted application programming interface and an adapter are written in a platform independent programming language (col. 4, lines 15-20).

12. Regarding Claim 5, Monberg teaches Java (col. 6, lines 14-26).

13. Regarding Claim 6, Monberg teaches lightweight directory access protocol compliant (col. 6, lines 14-26).

14. Regarding Claim 7, Monberg teaches Microsoft Exchange Address Book (col. 6, lines 14-26).

15. Regarding Claim 8 and 21, Monberg teaches establishing an abstraction of a session (col. 4, lines 60-67, col. 5, lines 1-9, col. 8, lines 17 and 18, figure 2, element 220); implementing an abstraction of a session (col. 4, lines 60-67, col. 5, lines 1-9, col.

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8, lines 17 and 18, figure 2, element 220); creating an abstraction of opening of an address book program (col. 4, lines 60-67, col. 5, lines 1-9, col. 8, lines 17 and 18, figure 2, element 220); implementing an abstraction of opening an address book program (col. 4, lines 60-67, col. 5, lines 1-9, col. 8, lines 17 and 18, figure 2, element 220); generating an abstraction of an operation of an address book program (col. 4, lines 60-67, col. 5, lines 1-9, col. 8, lines 17 and 18, figure 2, element 220); and implementing an abstraction of an operation on an address book program (col. 4, lines 60-67, col. 5, lines 1-9, col. 8, lines 17 and 18, figure 2, element 220).

16. Regarding Claim 10, 11, Monberg teaches a first and second abstract class

17. Regarding Claim 12-17, 19, 20, and 22-27, the limitations of these claims have been noted in the rejections of the claims presented above. They are therefore rejected as set forth above.

18. Regarding Claims 18 and 19, the limitations of these claims have been noted in the rejections of claims 1-20 presented above. In addition, Monberg teaches a third abstract class (col. 4, lines 60-67, col. 5, lines 1-9, col. 8, lines 17 and 18, figure 2, element 220).

NAME OF CONTACT

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Lewis whose telephone number is (571) 272-4113. The examiner can normally be reached on 6:30-3:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cottingham can be reached on (571) 272-7079. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

(571) 273-4113 (Use this FAX #, only after approval by Examiner, for "INFORMAL" or "DRAFT" communication. Examiners may request that a formal paper/amendment be faxed directly to them on occasions.).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/ Technology Center (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Cheryl Lewis". The signature is fluid and cursive, with a large initial "C" and "L".

Cheryl Lewis
Patent Examiner
September 29, 2006